

ESTTA Tracking number: **ESTTA74230**

Filing date: **04/03/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92045274
Party	Plaintiff Deborah Stoller
Correspondence Address	Lawrence E. Abelman Abelman Frayne & Schwab 666 Third Avenue New York, NY 10017 mamastrovito@lawabel.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Marie Anne Mastrovito
Filer's e-mail	mamastrovito@lawabel.com
Signature	/mam/
Date	04/03/2006
Attachments	33900001.pdf (12 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF

Trademark Registration No. 2,596,818, Issued July 23, 2002

DEBORAH STOLLER

Petitioner,

v.

SEW FAST/SEW EASY, INC.

Respondent

:
:
:
:
:
:
:
:
:

Cancellation No. 92045274

**PETITIONER'S MOTION FOR LEAVE TO FILE
AMENDED PETITION TO CANCEL**

Petitioner request leave to Amend the Petition to Cancel pursuant to Rule 15(a) of the Federal Rules of Civil Procedure.

Petitioner submits that justice requires that such amendment be permitted because Respondent's discovery responses have revealed several additional grounds for cancellation. Based on the discovery responses, Petitioner believes that Respondent's Mark was not used on the services identified in the registration at the time the application was filed, and that the dates of use alleged are not accurate. Petitioner therefore seeks to add claims based on this newly discovered information.

Petitioner received Respondent's responses to its first set of Interrogatories and Document Requests on March 17, 2006. Review of these responses and document requests has shed further light on the nature of Respondent's use, and non-use, of the wording STITCH & BITCH CAFÉ. Respondent has acted promptly to amend its Petition

to Cancel after learning of the additional grounds for cancellation through these discovery responses.

Petitioner's proposed Amended Petition to Cancel is attached. In addition to adding new claims based on the information revealed in discovery, Petitioner has corrected a few non-substantive typographical and grammatical errors in the original claims, such as, correcting the word "Registrations," to read "Applications," in Paragraph 7, and deleting the repetition of the wording "merely descriptive," in Paragraph 8.

Petitioner submits that the amendment of the Petition to Cancel at this time, will not prejudice Respondent because the discovery period is not scheduled to close until August 8, 2006. Thus, Respondent has many months in which to conduct discovery relating to the new claims.

WHEREFORE, Petitioner requests that the Board grant this Motion for Leave to Amend, and accept the attached Amended Petition to Cancel to replace the original Petition to Cancel submitted November 4, 2005.

Respectfully submitted,

ABELMAN, FRAYNE & SCHWAB
Attorneys for Petitioner

Date: April 3, 2006

By:


LAWRENCE E. ABELMAN
MARIE-ANNE MASTROVITO

150 East 42nd Street
New York, New York 10017
(212) 949-9022

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **PETITIONER'S MOTION FOR LEAVE TO FILE AMENDED PETITION TO CANCEL** was served by first class mail, postage prepaid, this 3rd day of April upon counsel for Respondent:

Georges Nahitchevansky, Esq.
Kilpatrick Stockton LLP
31 West 52nd Street
New York, New York 10019


MARIE-ANNE MASTROVITO

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF

Trademark Registration No. 2,596,818, Issued July 23, 2002

DEBORAH STOLLER

Petitioner,

v.

SEW FAST/SEW EASY, INC.

Respondent

:
:
:
:
:
:
:

Cancellation No. 92045274

AMENDED PETITION TO CANCEL

DEBORAH STOLLER, an individual, citizen of the United States, believes that she will be damaged by the above identified registration and hereby petitions to cancel the same pursuant to Section 14 of the Trademark Act of 1946, as amended (15 U.S.C. 1064). As grounds therefore it is alleged that:

1. Petitioner, **Deborah Stoller**, is the author of the popular books "Stitch 'n Bitch: The Knitter's Handbook," and "Stitch 'n Bitch Nation," both of which have been listed on *The New York Times* bestseller list .
2. Petitioner owns a pending application for the mark STITCH 'N BITCH in connection with a series of books in the field of knitting, filed on May 12, 2004, which has been assigned Serial No. 78/417575 ("Petitioner's '575 Application").
3. Petitioner owns a pending application for the mark STITCH 'N BITCH in connection with bags and cases for knitting materials and supplies, filed on May 12, 2004, which has been assigned Serial No. 78/417582 ("Petitioner's '582 Application").

4. Petitioner owns a pending application for the mark STITCH 'N BITCH in connection with entertainment services, namely, a television show in the field of knitting, filed on May 12, 2005, which has been assigned Serial No. 78/417593 ("Petitioner's '593 Application").

5. Petitioner owns a pending application for the mark STITCH 'N BITCH in connection with knitting kits, filed on May 12, 2005, which has been assigned Serial No. 78/417589 ("Petitioner's '589 Application").

6. Respondent's Registration No. 2596818 ("Respondent's Registration") covers the mark STITCH & BITCH CAFÉ ("Respondent's Mark") in connection with "providing on-line chat rooms for the transmission of messages among computer users concerning sewing via a global computer network," and "sewing instruction and manuals distributed in connection therewith" ("Respondent's Services").

7. Petitioner's '575, '582, '593 and '589 Applications have all been refused registration under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with the mark shown in Respondent's Registration.

8. The word CAFÉ is widely used in connection with chat rooms and is merely descriptive of this type of Internet service.

9. Respondent's Registration includes a disclaimer of the exclusive right to use the word CAFE apart from the mark as shown. Thus, Respondent has conceded that this wording is merely descriptive of the services covered by Respondent's Registration.

10. The "&" in the Respondent's mark is the equivalent of the word "and."

11. The wording "stitch and bitch," and variations thereof such as "stitch & bitch," has been used to identify groups of sewers and knitters, the places where they gather to chat and

sew/knit, or the gatherings themselves, for many years and such use began long before Respondent's alleged first use of the mark STITCH & BITCH CAFÉ in 1998.

12. The wording "stitch & bitch" is merely descriptive of the services covered by the Respondent's registration because the services identified in the registration are, in essence, a virtual stitch and bitch group /club, and a stitch and bitch group where sewing instruction is provided.

13. In view of the foregoing, Respondent's Mark should be precluded from continued registration based on Section 2(e) of the Trademark Act, 15 U.S.C. 1052(e), because the mark as a whole is merely descriptive of the services covered by the registration.

14. Numerous third parties across the United States use the wording "stitch and bitch" (and variations thereof) as the generic or descriptive name of their group or club, to identify a type of get together, or to identify informational websites and chat rooms for sewers and knitters.

15. On information and belief, Respondent has taken no action to preclude most third parties from using "stitch & bitch," "stitch and bitch," or other highly similar variations thereof, in connection with services which are the same as, or closely related to, Respondent's services.

16. On information and belief, any goodwill which may ever have been associated with the wording "stitch & bitch" in the Respondent's Mark has been destroyed by numerous third party uses of the same, or highly similar wording, in connection with services which are the same as, or closely related to, the services identified in Respondent's Registration.

17. On information and belief, any rights which Respondent may have held in the wording "stitch & bitch" have been abandoned by failure to police third party uses.

18. Respondent's mark will not be perceived as a source indicator, because of the widespread use of the wording "stitch and bitch", and variations thereof, by third parties to identify

similar or identical services, and the admitted descriptiveness of the word CAFE. Thus, the mark should be precluded from registration under Sections 1, 2 and 45 of the Trademark Act, because it does not function as a trademark.

19. In the application for Respondent's Mark ("Respondent's application), Respondent claims use of Respondent's Mark in connection with "providing on-line chat rooms for the transmission of messages among computer users concerning sewing via a global computer network" in Class 38 ("Respondent's Class 38 services").

20. The terminology "chat rooms," identifies an on-line venue where users conduct interactive messaging to communicate with each other in real time regarding a common interest.

21. On information and belief, the Respondent's only on-line use of the mark STITCH & BITCH CAFÉ at the time Respondent's application was filed was in connection with a guest book where visitors could post various messages at Respondent's web site .

22. On information and belief, at the time the Respondent's application was filed Respondent's Mark was not in use in connection with providing an on-line venue where users could communicate with each other in real time.

23. On information and belief, at the time the Respondent's application was filed Respondent's Mark was not in use in connection with providing on-line interactive messaging.

24. On information and belief, at the time the Respondent's application was filed, the services with which Respondent was using Respondent's Mark did not include "providing on-line chat rooms for the transmission of messages among computer users concerning sewing via a global computer network."

25. The class heading for International Class 38 identifies the services covered by this

class as "telecommunications."

26. On information and belief, at the time Respondent's application was filed Respondent did not provide actual telecommunications connections to its guest book, the means by which messages were left on its guest book, or the means for transferring such messages.

27. On information and belief, at the time Respondent's application was filed Respondent was not using the Respondent's Mark in connection with any services falling in Class 38.

28. On information and belief, Respondent's use of Respondent's Mark on its web site, at the time the Respondent's application was filed did not constitute use of the mark as a trademark or service mark because the Respondent was not using the Respondent's mark in connection with any actual services as that term is defined by Section 45 of the Trademark Act.

29. In Respondent's application, Respondent claims first use of Respondent's Mark in connection with Respondent's Class 38 services as of November 1, 1998.

30. On information and belief Respondent's Mark was not used in connection with Respondent's Class 38 services as of November 1, 1998.

31. On information and belief, Respondent knew, or should have known, that the Respondent's Mark was not being used in connection with Respondent's Class 38 services at the time the Respondent's application was filed.

32. On information and belief, Respondent knew, or should have known that the Respondent's Mark was not in use in connection with Respondent's Class 38 services as of November 1, 1998.

33. On information and belief, upon reasonable reliance on the truth of Respondent's

misrepresentations and false statements that the mark was in use on the services identified in Class 38, and that such use commenced on or about the dates of first use claimed in the application, the Examiner allowed the mark for publication.

34. On information and belief, had the Examiner been aware of the misrepresentations and false statements regarding the actual services with which the mark had been used, and the alleged dates of use, the application would have been refused.

35. On information and belief, Respondent's registration should be found to be void in its entirety, in view of the Respondent's false statements and misrepresentations in the application as to the actual services with which the mark was in use.

36. On information and belief, Respondent's registration should be found to be void in its entirety, in view of the Respondent's false statements and misrepresentations in the application as to the dates on which the mark was first used in connection with Respondent's Class 38 services.

37. In Respondent's application, Respondent claims use of Respondent's Mark in connection with "sewing instruction and manuals distributed in connection therewith," in Class 41 ("Respondent's Class 41 services").

38. In Respondent's application for Respondent's Mark, Respondent claims first use of Respondent's Mark in commerce in connection with Respondent's Class 41 services as of November 1, 1998.

39. On information and belief, Respondent was not using Respondent's mark in connection with Respondent's Class 41 services as of November 1, 1998.

40. On information and belief, Respondent was not using Respondent's mark in connection with Respondent's Class 41 services at the time Respondent's application was filed.

41. On information and belief, at the time the application was filed, Respondent's only actual use of the mark, other than in connection with its on-line guest book, was in connection with get togethers for sewers at Respondent's place of business.

42. On information and belief, if Respondent was making any use of Respondent's Mark in connection with Respondent's Class 41 services at the time the Respondent's application was filed such use was a token use solely for the purposes of reserving rights in the mark, and that such use was abandoned shortly thereafter.

43. On information and belief, if Respondent made any use of Respondent's Mark in connection with the Class 41 services, such use was discontinued in connection with these services for at least a three year period between the date on which Respondent's application was filed and the date on which the Petition to Cancel was filed.

44. On information and belief, if Respondent ever used Respondent's mark in commerce in connection with Respondent's Class 41 services, Respondent abandoned the mark in connection with these services based on non-use.

45. On information and belief, any advertisements or promotional materials distributed in connection with Respondent's Class 41 services at or prior to the date on which the Respondent's application was filed, were only distributed locally and were not distributed in commerce.

46. On information and belief, Respondent's Mark had not been used in interstate commerce, or other commerce which may be regulated by Congress, in connection with the Respondent's Class 41 services as of November 1, 1998.

47. On information and belief, Respondent's mark had not been used in interstate

commerce, or other commerce that may be regulated by Congress, in connection with Respondent's Class 41 services at the time the Respondent's application was filed.

48. On information and belief, Respondent knew, or should have known, that the Respondent's Mark was not being used in connection with Respondent's Class 41 services at the time the Respondent's application was filed.

49. On information and belief, Respondent knew, or should have known that the Respondent's Mark was not in use in connection with Respondent's Class 41 services as of November 1, 1998.

50. On information and belief, at the time the Respondent's application was filed Respondent knew or should have known that the Respondent's Mark was not being use in interstate commerce, or other commerce which may be regulated by Congress, in connection with Respondent's Class 41 services on the date of first use in commerce claimed in the application.

51. On information and belief, at the time the Respondent's application was filed, Respondent knew or should have known that the Respondent's Mark was not being use in interstate commerce, or other commerce which may be regulated by Congress, in connection with Respondent's Class 41 services.

52. On information and belief, upon reasonable reliance on the truth of Respondent's misrepresentations and false statements that the mark was in use in commerce on the services identified in Class 41, and that such use commenced on or about the date of first use claimed in the application, the Examiner allowed the mark for publication.

53. On information and belief had the Examiner been aware of the misrepresentations and false statements made by Respondent regarding the actual services with which the mark had

been used, the alleged dates of use, and the use of the mark in commerce, the application would have been refused.

54. Respondent's registration should be found to be void in its entirety, in view of the Respondent's false statements and misrepresentations in the application as to the alleged dates of use of the Respondent's Mark in connection with Respondent's Class 41 services.

55. Respondent's registration should be found to be void in its entirety, in view of the Respondent's false statements and misrepresentations in the application as to the Respondent's use of the Respondent's Mark in commerce in connection with Respondent's Class 41 services.

56. On information and belief, Respondent's registration should be cancelled because the Respondent's Mark was not in use in commerce in connection with Respondent's Class 41 services at the time the application was filed based on an alleged use of the mark in commerce.

WHEREFORE, Petitioner believes that it has a real interest in this proceeding and will be irreparably damaged by the continued registration of the Respondent's Mark, and respectfully requests that the Board sustain this cancellation action and cancel Registration No. 2596818.

Respectfully submitted,

ABELMAN, FRAYNE & SCHWAB
Attorneys for Petitioner

Date: April 3, 2006

By:


LAWRENCE E. ABELMAN
MARIE-ANNE MASTROVITO

150 East 42nd Street
New York, New York 10017
(212) 949-9022